

REMARKS

Applicants gratefully acknowledge the withdrawal of the rejections of claims 1-23 and 26-85 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,891,120 to Chmielewski ("Chmielewski"), and claims 24 and 25 under U.S.C. § 103(a) as being unpatentable over Chmielewski in view of Roberts.

Claims 1-85 remain pending in the application. Claims 1-12, 14-23, 26-39, and 42-85 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Qin et al. (6,469,130). Claims 13-14, 24-25 and 40-41 are rejected under U.S.C. § 103(a) as being unpatentable over Qin, as applied to claims 1, 16, and 28 above, and further in view of U.S. Patent No. 3,875,942 to Roberts, *et al.* Applicant respectfully requests reconsideration and allowance of each pending claim in view of the following remarks.

Rejection of claims 1-12, 14-23, 26-39 and 42-85 as anticipated by or obvious over Qin

In the Office Action, the Examiner correctly notes that Qin remains silent as to the Gel Integrity Index of the superabsorbent polymer recited in the present claims. See Office Action, page 2, ¶3. However, the Examiner incorrectly, and without any rationale or evidentiary support, asserts that the superabsorbent polymer of Qin inherently fulfills the claimed limitation.

As set forth in MPEP §2112.IV, to establish a rejection based on inherency the Examiner must provide rationale or evidence tending to show inherency as follows:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art. (citation omitted)

Further, “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *Id.* (citation omitted).

The Examiner alleges that “the polymer disclosed by Qin is described in the instant specification as being suitable for the instant invention”. However, the Examiner fails to indicate exactly where the instant specification describes the polymer disclosed by Qin as being suitable for the instant invention. In fact, Qin merely appears to describe a generic polyacrylate potentially having one characteristic in common with the superabsorbent polymer recited in the present claims. As evidence of the wide disparity in physical properties between various polyacrylate superabsorbent polymers, for example, Applicant directs the Examiner’s attention to Exhibit 1, in which the product data sheets for various polyacrylates are provided. In contrast, the presently claimed invention clearly places additional limitations on the superabsorbent polymer, e.g., the Gel Integrity Index, which are entirely absent from Qin.

Moreover, the superabsorbent of the instant invention appears to be structurally distinct from that of Qin. For example, the superabsorbent of the present invention, when in particulate form, has a particle size of 50 to 1,000 microns (Specification, page 11, lines 4-6), while Qin describes fibers having a mean fiber diameter in the range of from about 0.1 to about 10 microns (col. 4, lines 46-48). Thus, the teachings of Qin appear to be entirely inconsistent with the superabsorbent recited in the present claims.

Additionally, it is unclear from Qin that a low Gel Integrity Index would even be desired or consistent with Qin’s disclosed invention. The purpose of Qin is to prepare a substantially continuous superabsorbent microfiber having mechanical strength, high fluid absorbency and preferred handling properties. Col. 2, lines 43-48. In contrast to the instant specification, Qin does not at all mention the importance of resistance to flow as measured by penetration resistance of the gel slurry formed when the

superabsorbent material is subjected to a high level of liquid loading. See specification, page 10, lines 3-10.

Further, Applicant respectfully submits that there is no extrinsic evidence of record to support the assertion of inherency. As provided in the MPEP, “[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” MPEP 2131.01.III (8th ed., rev. 2) (citing *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). Here, there is no evidence that a superabsorbent polymer having an AUL value within the claimed range (even if the reference had disclosed such) will also necessarily have a Gel Integrity Index range within the claimed range. In the absence of such evidence, a prima facie case of inherent anticipation is not established. Moreover, Applicant again notes that superabsorbent polymers are highly complex structures whose physical properties may vary largely dependent upon various characteristics, such as the amount of crosslinking, for example, and thus they could differ from one another in a variety of ways while also sharing similar properties.

Finally, the present application states that “Persons of ordinary skill in the art would be readily able to prepare and identify superabsorbent polymers meeting these characteristics, without undue experimentation, *based upon the guidance provided herein.*” See Specification, Page 8, lines 7-9. [emphasis added] Accordingly, it is only with the guidance provided in the specification that the claimed characteristics would be appreciated and selected from the multitude of possibilities.

In view of the foregoing, Applicant respectfully submits that there is no evidence that the superabsorbent polymer disclosed in the reference is has the “same chemical structure” as the claimed polymer. In fact, given the complexity of structure of the polymers, the evidence would suggest the opposite.

As the Examiner has not provided sufficient rationale or evidence to meet her burden of establishing inherency, the burden has not shifted to Applicant. Accordingly, for at least the reasons provided above, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection and allow pending claims 1-23 and 26-85.

Rejections under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that the burden of establishing a *prima facie* case of obviousness has not been met by the Examiner in this case. Moreover, even if a *prima facie* case of obviousness was established, it would be rebutted by secondary evidence of nonobviousness.

Rejection of Claims 13-14, 24-25 and 40-41 over Qin in view of Roberts

Claims 13-14, 24-25 and 40-41 are rejected under U.S.C. § 103(a) as being unpatentable over Qin, applied to claims 1, 16, and 28 above, and further in view of U.S. Patent No. 3,875,942 to Roberts, *et al.*

In view of the foregoing arguments, Applicant submits that Qin is deficient for number of reasons, and in particular for failing to disclose an absorbent article comprising an absorbent article that has a GII of less than about 500 kg mm, as recited

by claim 16. Roberts fails to overcome the fundamental deficiency of the Qin patent because it also fails to teach or suggest the recited physical properties of the superabsorbent. Therefore, the prior art references in combination do not teach or suggest all the claim limitations, and do not support a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw these rejections and allow the pending claims.

CONCLUSION

For at least the reasons outlined above, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and allowance of the pending claims are respectfully solicited. Should there be anything further required to place the application in better condition for allowance, Examiner Anderson is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
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